

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 13-15, 21-23, 27, 28, 47-52, 57, 58 and 74 are now pending in this application. Claims 13, 14, 47 and 48 have been amended to remove references to peptides and other phosphinothricine derivatives of said peptide radicals. . No new matter has been added by this amendment. [Applicants wish to verify that the previous office action was an examination on the claims presented in the 3 July 2006 response as the cover of the most recent office action did not refer to claim 13 (which is still pending) nor did it acknowledge that claims 53-56 had been cancelled.]

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 112, 1st PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 14, 15, 21-23, 27, 28, 47-58 and 74 were rejected as allegedly lacking of enablement rejection. The applicants request reconsideration of this rejection for the following reasons. In order to advance prosecution, claims 13, 14, 47 and 48 have been amended to remove references to to other phosphinothricine derivatives of said peptide radicals. However, regardless of whether the amendment had been made or not, the applicants still would have objected to lack of enablement rejection of the claims as there as there appears to have been insufficient consideration of the *Wands* factors as set forth in MPEP 2164.01(a) which states in part: "It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis ***must consider all the evidence related to each of these factors***, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407. (emphasis added).

MPEP 2164.04 - Burden on the Examiner Under the Enablement Requirement states in part “[w]hile the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP § 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written enablement rejection. The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by ***making specific findings of fact, supported by the evidence***, and then drawing conclusions based on these findings of fact. References should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). However, ***specific technical reasons are always required***. In accordance with the principles of compact prosecution, if an enablement rejection is appropriate, ***the first Office action on the merits should present the best case*** with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal. Providing the best case in the first Office action will also allow the second Office action to be made final should applicant fail to provide appropriate convincing arguments and/or evidence.”

Not only was there an insufficient *Wands* analysis for undue experimentation, the statements mischaracterized the invention and provided no support for even the limited conclusions which were made, i.e. the statement that “peptides and esters are structurally and functionally different from glufosinate and salts thereof” is unclear as all of the compounds have the same basic structure of formula (A1) with the difference being the nature of variable Z.

In addition, there were no “findings of fact, supported by the evidence” or “specific technical reasons” provided; only unsubstantiated conjecture.

The office action pointed out the lack of working examples for glufosinate peptides and esters as though this was determinative of lack of enablement. However, this would be incorrect. See MPEP 2164.02 - “When considering the factors relating to a determination of non-enablement, if all the other factors point toward enablement, then the absence of working examples will not by itself render the invention non-enabled. In other words, lack of working

examples or lack of evidence that the claimed invention works as described ***should never be the sole reason for rejecting the claimed invention on the grounds of lack of enablement.***” (emphasis added).

The office encourages identifying enablement issues with the first Office action on the merits. While the applicants can understand if this rejection had been overlooked once and was issued as part of a second Office action, this is the ***seventh Office action on the merits*** which appears to be *prima facie* evidence that no undue experimentation issue exists.

Lastly, whatever merits existed for the lack of enablement rejection, they are believed to have been eviscerated by the limitation to claims 13, 14, 47 and 48 which remove the generic reference to peptide derivatives and esters.

III. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 14, 15, 21-23, 27, 28, 47-58, 74 were rejected as allegedly being obvious by Ruegg et al (US 6180563; 1/30/01). The applicants request reconsideration of this rejection for the following reasons.

As noted in the office action, Ruegg teaches the use of trifloxysulfuron with a compound of formula (IV) which includes glyphosate or glufosinate. This is the proper interpretation of Ruegg when considered as a whole. The office action was also proper to assert that Ruegg also does not explicitly teach a combination of glufosinate with other herbicides such as metolachlor, pyriithiobac, sethoxydim and clethodim.

However, what is not proper is the assertion that it would have been obvious to combine the herbicides based on the disclosure of Ruegg. The Ruegg reference never recognizes a benefit outside of a combination with trifloxysulfuron. Placing the Ruegg reference in front of one of ordinary skill in the art in the absence of the applicants’ claims to act as a blueprint would not have resulted in the presently claimed compositions. Moreover, it has long been held that it is improper to pick and choose among isolated disclosures from within the prior art.¹

Lastly, the specification provided evidence of secondary considerations with regard to the use of glufosinate ammonium in combination with 8 different herbicides (see pages 32 and 33 of

¹ See *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998)

the specification). No evidence rebutting these unexpected results has ever been provided which establishes why the scope of the claims presented are not allowable in light of these results.

For any of the above reasons, Ruegg does not render the applicants' claims *prima facie* obvious.

IV. CONFIRMATION OF ALLOWABILITY OF CLAIMS 13 and 52

As there is no rejection of claim 13, it is presumed that this claim is allowable. Also claim 52 was held allowable in the previous Office Action, but no explanation was given as to why this claim is now not allowable.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /hcl/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,233 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500